

REMARKS

Claims 1-7 are pending in the present application and favorable action on the merits is earnestly solicited at present.

Claims Rejections under 35 U.S.C. § 103

Claims 1-3, 5, 6, and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Isozaki et al. US '960** (US Publication No. 2004/0089960 A1) in view of **Matsumoto et al. JP '827** (JP Publication No. 2001-311827).

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Isozaki et al. US '960** in view of **Matsumoto et al. JP '827** as applied to claim 1 above, and further in view of **Tsuchimoto et al. US '939** (US Pub. No. 2003/0197939 A1).

Reconsideration and withdrawal of each of the above rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

MPEP § 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP § 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) *combining prior art elements according to known methods to yield predictable results;*
- (b) *simple substitution of one known element for another to obtain predictable results;*
- (c) *use of known technique to improve similar devices (methods, or products) in the same way;*
- (d) *applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;*
- (e) *"obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success*
- (f) *known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;*
- (g) *some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.*

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP § 2143.03.

The Instant Invention and Its Advantages

The present invention relates to a method for producing an iodine type polarizing film which exhibits a high contrast. More specifically, independent claim 1 recites as follows:

A method for producing a polarizing film comprising the step of supplying a polyvinyl alcohol film in/on which iodine is adsorbed and oriented in an aqueous solution containing boric acid and dipping and treating said polyvinyl alcohol film with said aqueous solution, wherein an absorbance of said aqueous solution at a wavelength of 450 nm is maintained in a range of 0.13 or less.

The iodine type polarizing films produced according to the present inventive method are not only easily produced, but also have a higher contrast than conventional iodine type films. Further, the method of the present invention can be easily carried out in a continuous manner and can stably produce the inventive polarizing films with good productivity.

Distinctions Over the Cited Art

Isozaki et al. US '960 discloses a method for producing polarizing films. However, Isozaki et al. US '960 describes only the concentrations of boric acid, potassium iodide and zinc chloride, and a treating temperature in an aqueous solution (*i.e.*, 30°C) and a treating time (*i.e.*, 5 minutes dipping) in the Examples. As the USPTO acknowledges, Isozaki et al. US '960 does not teach that an absorbance of the aqueous solution of boric acid at a wavelength of 450 nm is maintained in a specific range of 0.13 or less.

The USPTO alleges that Matsumoto et al. JP '827 teaches an absorbance of the aqueous solution of boric acid at a wavelength of 450 nm. Although Matsumoto et al. JP '827 describes the absorbance of any one layer constituting a polarizing film at a wavelength of 450 nm, it never

teaches any absorbance of an aqueous solution of boric acid to be used for treating the polarizing film. Please see, in particular, paragraph [0013] and the Examples thereof.¹

Therefore, the USPTO's allegation with regard to Matsumoto et al. JP '827 is not correct, since the characteristics at a wavelength of 450 nm are those of a polarizing film and are not the property of a treating solution containing boric acid.

Accordingly, the present invention would not have been obvious from Isozaki et al. US '960 in view of Matsumoto et al. JP '827, since Matsumoto et al. JP '827 does not describe any absorbance of an aqueous solution containing boric acid which is used for treating a polyvinyl alcohol film.

Additionally, it is noted that the tertiary cited Tsuchimoto et al. US '939 reference does not cure the above-noted deficiencies of the cited Isozaki et al. US '960 and Matsumoto et al. JP '827 references, so that its combination with Isozaki et al. US '960 and Matsumoto et al. JP '827 is also incapable of rendering obvious any of the pending claims 1-7 currently under consideration.

Further to the above it is submitted that the applied prior art provides no disclosure and no reason or rationale that would allow one of ordinary skill in the art to arrive at the instant invention as claimed. This fact further supports the non-obviousness of the instant invention.

¹ The applicants are currently in the process of trying to obtain an English translation of the relevant parts of the cited Matsumoto et al. JP '827 reference and once the same is received at the offices of the undersigned it will be promptly forwarded to the USPTO for the Examiner's consideration.

Conclusion

Based on remarks presented herein, the USPTO is respectfully requested to issue a Notice of Allowance in the matter of the instant application, clearly indicating that each of instantly pending claims 1-7 is allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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